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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/360,521	07/23/1999	SERGE RESTLE	05725.0446-0	4299

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EXAMINER

WELLS, LAUREN Q

ART UNIT	PAPER NUMBER
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1617

DATE MAILED: 11/10/2003

32

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application N .

09/360,521

Applicant(s)

RESTLE ET AL.

Examin r

Lauren Q Wells

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 September 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-46 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-46 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 32 . 6) ☐ Other: _____

DETAILED ACTION

Claims 1-46 are pending. The Amendment filed 9/12/03, Paper No. 31, amended claims 1, 32, 34-38, and 44-46.

Applicant's arguments with respect to claims 1-46 have been considered but are moot in view of the new ground(s) of rejection.

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 9/12/03 has been entered.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 26 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

(i) Claim 26 is vague and indefinite, as it is not clear how the compound depicted by formula (II) can depend from those generic formulas recited in claim 1. Formula (II) of claim 26 is depicted as formula (I) of the instant invention, wherein the $-\text{CH}_2-\text{CH}(\text{CH}_3)-\text{CH}_2-\text{NH}-(\text{CH}_2)_2-\text{NH}_2$ chain of formula (II) is R' of formula (I), wherein R' is $-\text{C}_q\text{H}_{2q}\text{L}$. It is

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respectfully pointed out that the C_qH_{2q} does not allow for $CH(CH_3)$. Thus, it is not clear how formula (II) of claim 26 can depend on claim 1.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-32, 34-41 and 43-46 rejected under 35 U.S.C. 103(a) as being unpatentable over Decoster (6,451,747).

The instant invention is directed toward a composition comprising a washing base comprising an anionic and amphoteric surfactant, wherein the ratio of amphoteric:anionic is greater than or equal to 0.1:1, and a conditioner system comprising at least one aminated silicone having an amine number greater than or equal to 0.5 meq/g, and a cationic polymer.

Decoster teaches detergent and conditioning hair care compositions comprising, in a cosmetically acceptable medium, a washing base and a conditioning system comprising at least one cationic polymer and a mixture of at least one amine silicone and a grafted silicone polymer. Exemplified is a composition comprising 14g laurylethersulfate of sodium (anionic surfactant, 14% of composition), 1g laurylsulfate of ammonium (anionic surfactant, 1%), 4.6g cocoamidoethyl (N-hydroxyethyl, N-carboxymethyl) glycinate of sodium (amphoteric surfactant, 4.6%), 2.5 g amine silicone with an amine index of 0.5 meq/g (2.5%), 0.1g guar gum modified by chloride of 2,3-epoxypropyl trimethylammonium (cationic polymer, 0.1%), and water, wherein the ratio of amphoteric/anionic surfactant is 0.3:1. For cellulose ether derivatives

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containing quaternary ammonium groups, see Col. 6, lines 27-35. For cationic polysaccharides, see Col. 6, lines 49-56. For quaternary diammonium polymers of formula (a) of instant claim 35, see Col. 8, lines 16-26. For cationic polymers comprising 0.001-10% of the composition, see Col. 11, lines 1-5. For compounds of formula (I), formula (IV), and (II), and the limitations of claims 13-25 and 27-29, see Col. 17, line 4-Col. 19, line 16. For aminosilicones comprising 0.05-10% of the composition, see Col. 19, lines 17-21. For water or an aqueous alcoholic solution as the vehicle, see Col. 19, lines 22-24. For ethanol, isopropanol and butanol, see Col. 19, lines 24-25. For fragrances, preservatives, sequestering agents, thickeners, softeners, foam modifiers, dyes, and other adjuvants, see Col. 19, line 36-42. For a process for washing and conditioning keratin fibers, such as hair, see Col. 19, lines 62-67. The reference lacks an exemplification of the preferred aminated silicones and the amount of solvent.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to substitute the amodimethicone exemplified in Decoster for the compounds of Formulas (I), (IV) or (II) of the instant invention because Decoster teach these compounds as interchangeable aminated silicones for use in his compositions.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to teach the solvents of Decoster as comprising 0.1-20% of the composition because it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art (In re Aller, 105 USPQ 233) and because Decoster teaches his compositions in a variety of forms, such as liquids more or less thickened, creams and gels; thus, one of skill would be motivated to alter the amount of solvent in the composition to achieve specific composition forms.

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The recitations "detergent and conditioning cosmetic" in claim 1, and "for cleaning or removing make-up from keratinous substances, or for conditioning keratinous substances" in claim 44 have not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hira*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

Claims 33 and 42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Decoster as applied to claims 1-32, 34-41 and 43-46 above, and further in view of Naito et al. (5,476,649).

Decoster is applied as discussed above. The reference lacks 18-methyl-eicosanoic acid and polyalkylene glycols.

Naito et al. teach 18-methyl-eicosanoic acid as a branched fatty acid that imparts excellent conditioning effects to the hair and prevents the hair from being damaged, see abstract and Col. 1, lines 54-67. Polyalkylene glycols are taught as hair care ingredients that impart moisturization and flexibility to the hair.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to add 18-methyl-eicosanoic acid and/or polyalkylene glycol, as taught by Naito et al., to the composition of Decoster because of the expectation of achieving a hair care product that additionally conditions the hair and prevents it from being damaged, and/or imparts moisturization and flexibility to the hair.

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Claims 1-32, 34-41 and 43-46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Decoster (English Translation of WO 97/46211) in view of Hughes (5,567,428).

The instant invention is directed toward a composition comprising a washing base comprising an anionic and amphoteric surfactant, wherein the ratio of amphoteric:anionic is greater than or equal to 0.1:1, and a conditioner system comprising at least one aminated silicone having an amine number greater than or equal to 0.5 meq/g, and a cationic polymer.

Decoster exemplifies a shampoo composition comprising 14g laurylethersulfate of sodium (anionic surfactant, 14% of composition), 1g laurylsulfate of ammonium (anionic surfactant, 1%), 4.6g cocoamidoethyl (N-hydroxyethyl, N-carboxymethyl) glycinate of sodium (amphoteric surfactant, 4.6%), 2.5 g amine silicone with an amine index of 0.5 meq/g (2.5%), 0.1g guar gum modified by chloride of 2,3-epoxypropyl trimethylammonium (cationic polymer, 0.1%), and water, wherein the ratio of amphoteric/anionic surfactant is 0.3:1. For the washing base comprising 4-50% of the composition, see pg. 6, last paragraph. For perfumes, preservatives, sequestering agents, thickeners, softeners, foam modifiers, coloring agents, moisturizers, anti-dandruff/anti-seborrheic agents, vitamins, sun filters, and suspension agents, see pg. 28, 3rd paragraph. For derivatives of cellulose ethers that include quaternary ammonium groups and cationic polysaccharides, see pg. 16 (2) and (4). For cationic polymers of formula (a) of instant claim 35, see pg. 20 (10). For cationic polymers comprising 0.001-10%, see pg. 27, 1st paragraph. For a medium of water or water and alcohols, see pg. 28, 1st paragraph. For ethanol, isopropanol, and butanol, see pg. 28, 1st paragraph. For a process of washing and conditioning keratinic fibers, such as hair, see pg. 29, 3rd paragraph. The reference lacks a preferred aminated silicone and an amount of solvent.

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Hughes teach topical care compositions. For compounds of formula (I) and (III) of the instant invention, see Col. 13, line 57-Col. 14, line 19. Formula (III) is the same as the compound of the formula of Col. 13, line 60, when $n=0$, $a=0$, $b=1$, $m=1$, G is CH_3 , R_1 is $(\text{CH}_2)_3\text{-NH-}(\text{CH}_2)_2\text{-NH}_2$. For compounds of formula (IV) of the instant invention, see Col. 14, lines 33-56. For the limitations of instant claims 13-25 and 27-29, see Col. 13, line 40-Col. 14, line 59. These compounds are taught as providing hair hold and style hold benefits, while imparting a softer, less stiff feel to the hair. These compounds are exemplified for use in shampoo compositions. See Col. 1, lines 16-35; Col. 15, lines 48-51; Col. 34, lines 10-45.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to substitute the aminated silicones taught by Hughes for those of Decoster because of the expectation of achieving similar aminated silicone properties in hair care formulations and because of the expectation of achieving a product that cleanses the hair, while imparting styling hold benefits that do not leave the hair feeling stiff. It is further respectfully pointed out that the substitution of one aminated silicone for another is obvious and within the skill of the artisan.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to teach the solvents of Decoster as comprising 0.1-20% of the composition because it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art (In re Aller, 105 USPQ 233) and because Decoster teaches his compositions in a variety of forms, such as liquids more or less thickened, creams and gels; thus, one of skill would be motivated to alter the amount of solvent in the composition to achieve specific composition forms.

Claims 33 and 42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Decoster in view of Hughes as applied to claims 1-32, 34-41 and 43-46 above, and further in view of Naito et al. (5,476,649).

Decoster and Hughes are applied as discussed above. The references lack 18-methyl-eicosanoic acid and polyalkylene glycols.

Naito et al. teach 18-methyl-eicosanoic acid as a branched fatty acid that imparts excellent conditioning effects to the hair and prevents the hair from being damaged, see abstract and Col. 1, lines 54-67. Polyalkylene glycols are taught as hair care ingredients that impart moisturization and flexibility to the hair.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to add 18-methyl-eicosanoic acid and/or polyalkylene glycol, as taught by Naito et al., to the composition of the combined references because of the expectation of achieving a product that conditions the hair and prevents it from being damaged, and/or imparts moisturization and flexibility to the hair.

Conclusion

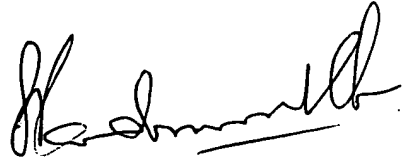
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lauren Q Wells whose telephone number is (703) 305-1878. The examiner can normally be reached on M-F (7-4:30), with alternate Mondays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan can be reached on (703)305-1877. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1234.

lqw


SREENI PADMANABHAN
SUPERVISORY PATENT EXAMINER
10/15/03